

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

JPD-4398-211

Application Number	Filed
10/090,173	March 6, 2002
First Named Inventor	Gunaratnam
Art Unit	Examiner
3771	Annette Fredricka Dixon

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

Applicant/Inventor

/John P. Darling/

Signature

Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

John P. Darling

Attorney or agent of record

44,482

Typed or printed name

(Reg. No.)

703-816-4887

Requester's telephone number

Attorney or agent acting under 37CFR 1.34.

Registration number if acting under 37 C.F.R. § 1,34 _____

July 16, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

*Total of 1 form/s are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and selection option 2.

STATEMENT OF ARGUMENTS

The following listing of clear errors is responsive to the Office Action mailed April 25, 2008, each of which errors independently should result in reversal and withdrawal of all of the rejections.

Claims 39, 62, 63, 78-81, 85 and 86 were rejected under 35 U.S.C. § 103(a) over Rudolph (U.S. 6,192,886). With respect to independent claims 39, 62, and 63, the examiner acknowledges on page 3, lines 1-9, that Rudolph does not expressly disclose the first connector portion to be a female connector and the second connector portion to be a male connector, but concludes that it would have been obvious to have the first connector to be female and the second connector to be male and attached to the strap “since it has been held that rearranging parts of an invention involves only routing skill in the art.” The examiner cites In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) in support of the determination of obviousness. The examiner also concludes that “one of ordinary skill in the art would not expect the rearrangement of parts to adversely affect the effectiveness of the mask to be secured to the patient for operation.”

On page 19 of the response filed November 20, 2007, Applicants traversed the examiner’s reliance on the rationale used by the court in In re Japikse. Applicants provided a discussion of the facts of In re Japikse and, on page 20 of the November 20, 2007 response, Applicants clearly contrasted the facts of the instant application to the facts of In re Japikse and explained why the proposed modification of the mask of Rudolph would result in a change of operation of the mask and why one of ordinary skill in the art would not modify the mask of Rudolph in the manner proposed by the examiner. Applicants reiterated these arguments on page 19 of the response filed April 8, 2008.

In response to Applicants’ arguments, the examiner, on page 7, paragraph number 6, of the April 25, 2008 Office Action states that “Applicant has not provided the examiner with any proof or reasoning as to how or why the arrangement of the male and female connectors from the mask region to the strap region would inhibit the operation and ability of the airflow mask to properly function.”

It is respectfully submitted that Applicants are not required to provide the examiner any proof or reasoning that the proposed modification to the mask of Rudolph would inhibit the operation and ability of the airflow mask to properly function. The examiner relies solely on the rationale of the court in In re Japikse in determining the obviousness of independent claims 39, 62, and 63. As noted in the previous replies, MPEP § 2144.04 requires that the facts of the prior legal decision be sufficiently similar to the facts of the application before the examiner may use the rationale used by the court to determine obviousness. Applicants clearly provided reasoning,

on pages 19-20 of the November 20, 2007 response, as to why the facts of In re Japikse are not sufficiently similar to the instant application to permit the examiner to rely on the rationale used by the court. Applicants clearly explained how the proposed modification to the mask of Rudolph would result in a change of operation of the mask.

Moreover, Applicants did in fact provide reasoning as to why the proposed modification would inhibit the operation and ability of the mask of Rudolph to properly function. On page 20, lines 5-13 of the November 20, 2007 response, Applicants clearly argued that Rudolph discloses that one of the objectives of his invention is to provide a nasal cup formed from flexible material. See column 2, lines 38-39. Rudolph further discloses that the strap securement buttons 90 are integrally formed on the outer surface of the nasal cup 13 and the strap fasteners 10 are secured to a respective button by pressing the flexible button 90 through a respective button receiving aperture 93 in the fastener 10. Therefore, the formation of the strap securement buttons 90 (i.e. male connectors) on the nasal cup 13 is necessary for Rudolph to achieve his objective of a flexible nasal cup.

It is respectfully noted that the examiner has not provided any response to these arguments, as required by MPEP § 707.07(f).

The examiner has also improperly grouped claims 39, 62, and 63 in contravention of MPEP § 707.07(d). Each of claims 62 and 63 recites, *inter alia*, with respect to each of the second connector portions, that outward end portions of the base wall member and the opposing wall structures define a generally C-shaped laterally facing surface contained within a single plane. This feature is not recited in claim 39.

The examiner also fails to identify any portion of Rudolph where this feature may be found as is required by 37 C.F.R. § 1.104(c)(2), nor does the examiner provide any response to Applicants' arguments as required by MPEP § 707.07(f).

Claim 62 also recites, *inter alia*, that each of the first connector portions has one of a resiliently biased locking element and a locking element receiving aperture and claim 63 also recites, *inter alia*, resiliently biased locking elements being movable between deflected and undeflected positions and being resiliently biased toward the undeflected position. Neither of these features, at least, is disclosed by Rudolph, nor does the examiner provide any indication of where such features may be found in Rudolph, as required by 37 C.F.R. § 1.104(c)(2) or any response to Applicants' arguments as required by MPEP § 707.07(f).

Claims 33-35, 71-76, 82, 83, 88-91, 92-103, 105 and 106 were rejected under 35 U.S.C. § 103(a) over Rudolph in view of Ferrero et al. (U.S. 5,657,493). With respect to independent claim 33, Applicants argued on page 22, line 11 through page 23, line 2, of the November 20,

2007 response that Rudolph fail to disclose or suggest 1) a male connector portion including a trailing portion that has a pair of spaced side portions and a crossbar extending transversely therebetween; 2) a male connector portion including a leading portion that has a pair of longitudinally extending side beams spaced slightly inwardly from the side portions, the leading portion including a crosspiece extending between the side beams and defining a leading edge of the male connector portion; 3) a male connector portion having a leading portion also including a cantilevered member extending from an intermediate portion of the crosspiece toward the trailing portion of the male connector portion, the cantilevered member being movable between deflected and undeflected positions and being resiliently biased toward the undeflected position, the cantilevered member including a locking element extending outwardly therefrom, the locking element being positioned on the cantilevered member generally spaced from the crosspiece; and 4) a leading portion of a male connector portion including a ridge structure adjacent the trailing portion and extending generally perpendicularly relative to the side beams.

The examiner has not provided any answer to the substance of these arguments, as required by MPEP §707.07(f). Page 4, paragraph number 4, of the April 25, 2008 Office Action also fails to identify any portion of Rudolph where these features are disclosed, as required by 37 C.F.R. § 1.104(c)(2).

Applicants also argued on page 23 of the November 20, 2007 response that Ferrero et al. do not cure any of the deficiencies of Rudolph discussed above with respect to claim 33. The examiner identifies the leading end of the male coupling portion 30 of Ferrero et al. as the portion containing the guide arm 44. The portion containing the guide arm 44 does not include a crosspiece from which a cantilevered member extends and does not correspond to the leading end of claim 33.

The strap retaining portion 36 of the first coupling portion 30 of Ferrero et al. does not correspond to the cantilevered member of claim 33. There is no disclosure or suggestion by Ferrero et al. that the strap retaining portion is movable between deflected and undeflected positions and is resiliently biased toward the undeflected position. As also discussed above, the strap retaining portion 36 does not extend from an intermediate portion of a crosspiece extending between side beams.

The Office Action also states that the latch member or keeper tooth 58 of Ferrero et al. correspond to the locking element of claim 33. However, as noted by Applicants in the previous replies, the latch member or keeper tooth 58 of Ferrero et al. is not positioned on a cantilevered member generally spaced from a crosspiece that extends between side beams. Accordingly, the latch member or keeper tooth 58 does not correspond to the locking element of claim 33.

The examiner has not provided any response to these arguments, as required by MPEP § 707.07(f). Instead, the examiner states on page 7, paragraph number 6, that “Applicant’s arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.” It is respectfully submitted that Applicants’ arguments regarding the failure of the combination of Rudolph and Ferrero et al. to disclose numerous claimed features are more than general allegations and fully comply with Rule 111(b).

With respect to the examiner’s reliance on the rationale used by the court in In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), it is respectfully submitted that the facts of that case are not sufficiently similar to the instant application to permit the examiner to rely on the court’s rationale in determining the obviousness of claims 95 and 96. In particular, as the combination of Rudolph and Ferrero et al. fails to disclose a cantilever member, a cross bar and a ridge structure, it could not have been obvious to one of ordinary skill in the art to modify the size of these elements.

Claims 77, 84, and 104 were rejected under 35 U.S.C. § 103(a) over Rudolph in view of Ferrero et al. and Sullivan (U.S. 5,243,971).

Sullivan et al. fail to cure the deficiencies of the combination of Rudolph and Ferrero et al. Therefore, even assuming it would have been obvious to combine the references, which Applicants do not concede, the combination would not present a *prima facie* case of obviousness.

The examiner on page 7, paragraph number 6, “presents prior art Lane (5,555,569) as extrinsic evidence of the teaching of a male connector(120) positioned on the strapping region and a female connector (106) positioned on the mask region for the purpose of retaining the mask region to the strap region. (Figure 7, Column 4).”

As was noted in the previous reply, MPEP § 706.02(j) states:

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is respectfully submitted that regardless of the application, or non-application, of Lane to the rejection, Lane fails to cure the deficiencies of Rudolph and the combination of Rudolph and Ferrero et al.

It is also respectfully submitted that the examiner has failed to correctly determine the scope and content of Lane. Lane does not disclose a female connector (106) positioned on the mask region for the purpose of retaining the mask region to the strap region, as alleged by the

examiner. Lane discloses that the female components 108 of the releasable male-female connectors 106 are each connected to the straps 80, 81 by an O-ring 114 and a web strip 116. The female component 108 is not secured to the mask 28" and thus does not cure the deficiencies of Rudolph and Ferrero et al. with respect to claims 33, 39, and 99. The female component 108 is not formed in one piece with the mask 28" and clearly does not cure the deficiencies of Rudolph with respect to claims 62 and 63. Accordingly, even if Lane were applied, the rejections would still fail to present a *prima facie* case of obviousness.